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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,110	01/16/2004	Marc Vincent Marini	0212.67006	7346
24978 7590 02/15/2008 GREER, BURNS & CRAIN 300 S WACKER DR 25TH FLOOR CHICAGO, IL 60606				
EXAMINER				
TALBOT, MICHAEL				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/760,110

Applicant(s)

MARINI ET AL.

Examiner

MICHAEL W. TALBOT

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
4a) Of the above claim(s) 15-25 is/are withdrawn from consideration.
5) ☒ Claim(s) 5-14 is/are allowed.
6) ☒ Claim(s) 1-4 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 18 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. In Applicant's response dated 03 March 2006, a provisional election was made without traverse to prosecute the invention of Species I, claims 1-14 with representative Figures 1-10. Therefore, Species II and III comprising claims 15-25 with representative Figures 11-22 are withdrawn from further consideration by the examiner, pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention. Therefore, in Applicant's response to this Office Action, claims 15-25 should be provided with the correct claim identifier as being "withdrawn" or "cancelled".

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kakiuchi et al. (US 2002/0017026). Kakiuchi et al. 2002/0017026 shows in Figures 8-12 a tool-less blade clamping apparatus (50) for a reciprocating tool having a plunger (52) with at least one radial aperture (52c) and a blade receiving slot (52a) at its forward end for receiving a blade (3) having a shank portion (3b) with a hole (3a) and outwardly extending shoulders (3c) on opposite sides thereof (Fig. 12). Kakiuchi et al. 2002/0017026 shows the shank configured to be inserted in the slot (Figs. 8-12) and the apparatus configured to be attached to the plunger and having an opening (Figs. 8-12) for receiving the blade shank therein. Kakiuchi et al. 2002/0017026 shows

the apparatus having an unclamped position (Figs. 8,9) and a clamped position (Figs. 10-12) wherein the shank portion of the blade can be inserted into the opening when in the unclamped position and securely retained therein with the shoulders engaging the apparatus (Fig. 12) when in the clamped position. Kakiuchi et al. 2002/0017026 shows the apparatus being biased via spring (54) toward the clamped position (paragraph [0067]) and being operable to maintain its unclamped position via a releasable retaining mechanism (operating sleeve 53, auxiliary sleeve 59, spring 54, blade lock control slot 53aa, blade lock slot 53ab, pin 55) when placed in said unclamped position (paragraph [0067]). Kakiuchi et al. 2002/0017026 shows the apparatus being released when the shoulders (3c) of the blade shank portion engage the apparatus as the shank portion is inserted into the opening and slot a predetermined distance to place the apparatus in the clamped position (Fig. 12 and paragraph [0067]) and the apparatus engaging the shoulders of the blade and pushing the blade shank portion outwardly (via block 56 and spring 57) when moved in the unclamped position.

4. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Kramer et al. (US 6,725,548). Kramer et al. '548 shows in Figures 1-13 a tool-less blade clamping apparatus (41) for a reciprocating tool having a plunger (44) with at least one radial aperture (64) and a blade receiving slot (62) at its forward end for receiving a blade (42) having a shank portion (48) with a hole (82) and outwardly extending shoulders (95) on opposite sides thereof (Figs. 2,4). Kramer et al. '548 shows the shank configured to be inserted in the slot, the apparatus configured to be attached to the plunger and having an opening (central apertures of cam collar 56, sleeve 58 and collar housing 59) for receiving the blade shank therein. Kramer et al. '548 shows the apparatus having an unclamped position (Fig. 7) and a clamped position (Fig. 6) wherein the shank portion of the blade can be inserted into the opening when in the unclamped position and securely retained therein with the shoulders engaging the apparatus (Figs 2,4)

when in the clamped position. Kramer et al. '548 shows the apparatus being biased via spring (54) toward the clamped position (col. 5, line 54-56) and being operable to maintain its unclamped position via a releasable retaining mechanism (cam collar 56 and collar housing 59 rotated to unclamped/release position by a user/operator and held there) when placed in said unclamped position (Fig. 7). Kramer et al. '548 shows the apparatus being released when the shoulders of the blade shank portion engage the apparatus (col. 5, lines 59-61) as the shank portion is inserted into the opening and slot a predetermined distance (col. 5, line 54 through col. 6, line 4) to place the apparatus in the clamped position and the apparatus engaging the shoulders and pushing the blade shank portion outwardly when moved in the unclamped position (col. 4, line 40-56).

With regards to claim 1, it has been held that a recitation that an element is "being configured to" perform a particular function is not a positive limitation and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the above reference, the apparatus is being operable to maintain its unclamped position when placed in said unclamped position by simply a user/operator holding the cam collar 56 and collar housing 59 in place. Since no "positive structure" is claimed with the phrase "said apparatus being configured to maintain its unclamped position when placed in said unclamped position", the Examiner is required to maintain a broad and reasonable interpretation that includes the tool-less blade clamping apparatus being capable of being placed in "a unclamped position" and "maintained in the unclamped position" independent of the mechanism to do so since Applicant has not recited any "positive claim limitations" requiring otherwise.

Allowable Subject Matter

5. The following is a statement of reasons for the indication of allowable subject matter:

Claims 5-14 are allowed.

Claim 5 is the sole independent claim.

The prior art of record fails to anticipate or make obvious the claimed construction of a tool-less clamping apparatus for a reciprocating tool of the type which has a reciprocating plunger having (1) a hollow cylindrical inner sleeve configured to fit around the plunger having structure engaging the slot so that the inner sleeve is axially movable and non-rotatable relative to the plunger and having at least one outwardly extending protrusion and an inner ramp surface at its forward end that is axially oriented and inclined radially outwardly in the rearward direction, (2) a hollow cylindrical outer sleeve configured to fit around the inner sleeve and move circumferentially and axially relative thereto, said outer sleeve having a circumferentially extending slot with a transverse axially extending slot extension and at least one recess in the inside surface thereof forming a diagonal wall oriented toward the front of said outer sleeve from said end of said elongated slot that has said transverse extension to said opposite end for contacting said protrusion therein, said recess diagonal wall causing said outer sleeve to rotate relative to said inner sleeve responsive to forward axial movement of said inner sleeve when the blade is inserted into the slot, and (3) a pin secured to the plunger and engaging said slot of said outer sleeve and limiting rotational movement of said outer sleeve between the ends of said circumferentially extending slot and axially between the ends of said transverse axially extending slot extension, solely or in combination, with the reciprocating plunger having at least one radially oriented aperture and a blade receiving slot, a blade having a shank portion with a hole and at least one outwardly extending shoulder located between the distal end of the shank and a main portion, a compression spring positioned to bias the inner sleeve forward, a detente

positioned in the plunger rod aperture configured to engage the aperture in the blade, the apparatus having an unclamped position wherein the blade can be inserted and a clamped position wherein the blade can be securely retained therein, at least one spring biasing apparatus towards the clamping position, a releasable retaining mechanism for holding the apparatus in its unclamped position when placed in the unclamped position,

Kakiuchi et al. (US 6,612,039) is the closest art of record.

Kakiuchi et al. '039 lacks (1) a hollow cylindrical inner sleeve configured to fit around the plunger having structure engaging the slot so that the inner sleeve is axially movable and non-rotatable relative to the plunger and having at least one outwardly extending protrusion and an inner ramp surface at its forward end that is axially oriented and inclined radially outwardly in the rearward direction, (2) a hollow cylindrical outer sleeve configured to fit around the inner sleeve and move circumferentially and axially relative thereto, said outer sleeve having a circumferentially extending slot with a transverse axially extending slot extension and at least one recess in the inside surface thereof forming a diagonal wall oriented toward the front of said outer sleeve from said end of said elongated slot that has said transverse extension to said opposite end for contacting said protrusion therein, said recess diagonal wall causing said outer sleeve to rotate relative to said inner sleeve responsive to forward axial movement of said inner sleeve when the blade is inserted into the slot, and (3) a pin secured to the plunger and engaging said slot of said outer sleeve and limiting rotational movement of said outer sleeve between the ends of said circumferentially extending slot and axially between the ends of said transverse axially extending slot extension.

Although it is well known to have an actuation sleeves and a bayonet pin, there is no teaching in the prior art of record that would, reasonably and absent impermissible hindsight, motivate one having ordinary skill in the art to so modify the teachings of Kakiuchi et al. '039 to

include the above described three features with there specific functions. Thus, for at least the foregoing reasons, the prior art of record neither anticipates nor rendered obvious the present invention as set forth in independent claim 5.

Response to Arguments

6. Applicant's arguments filed 22 January 2008 have been fully considered but they are not persuasive.

7. In response to applicant's argument that the Kramer et al. '548 reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the apparatus is maintained in an unclamped position via a "detent position", see page 13 second paragraph) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, as broadly recited in claim 1, the Kramer et al. '548 reference only needs to meet the claim limitation of "said apparatus being configured to maintain its unclamped position when placed in said unclamped position". There is no structure relied upon as claimed to maintain the apparatus in the unclamped position, especially no reference to a "detent position", it just needs to be capable of being maintained in the unclamped position which the Kramer et al. '548 reference clearly teaches via cam collar 56 and collar housing 59 rotated to unclamped/release position by a user/operator and held there.

Since no "positive structure" is claimed with the phrase "said apparatus being configured to maintain its unclamped position when placed in said unclamped position", the Examiner is required to maintain a broad and reasonable interpretation that includes the tool-less blade clamping apparatus being capable of being placed in "a unclamped position" and "maintained in

the unclamped position" independent of the mechanism to do so since Applicant has not recited any "positive claim limitations" requiring otherwise.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mrs. Monica S. Carter, may be reached at 571-272-4475.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filling papers not requiring a fee. It may also be used for filing

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papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. W. T./
Examiner, Art Unit 3722
12 February 2008

/Monica S. Carter/
Supervisory Patent Examiner, Art Unit 3722